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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,705	10/20/2000	Simon Robert Walmsley	NPA053US	7415

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AUSTRALIA

EXAMINER
MARC COLEMAN, MARTHE Y

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,705	WALMSLEY ET AL.	
	Examiner	Art Unit	
	Marthe Y Marc-Coleman	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6 and 8-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6 and 8-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2003 has been entered.

Specification

2. The specification is objected to because of the following informality:

(e) the "Stephen B. Wicker, Error Control Systems for Digital Communication and Storage, Prentice-Hall 1995" on page 15 lines 25-27 of the specification is not considered because a copy of such document is not submitted;

Correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6, and 8-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claims 6, and 8-10, "the printer being adapted to print the map and the coded data substantially simultaneously" is not in the specification";

"generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity or the position" is not in the specification.

In regard to claim 11, "comprising a non-electronic printed surface displayed coded data" is not in the specification.

"generating, using at least some of the decoded coded data, indicating data indicative of a position of the sensing device relative to the globe" is not in the specification.

In light of the 112 rejection the claims are examined as best understood by the Examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 6, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conroy et al. (U.S. Patent No. 5,686,705) in view of Dymetman et al. (Intelligent Paper; in Electronic Publishing Artistic Imaging, and Digital Typography)[1] and further in view of Dymetman (WO 99/50787)

In regard to claim 6, Conroy et al. discloses a system for enabling a user to designate, in a computer system **(30 in Fig. 1)**, at least one geographic location (or point of interest P in Fig. 2) (see col. 18 lines 44-52), the system including:

- a surface on which is disposed a map of a geographic area (see abstract), the geographic area including the at least one geographic location **(P)** (see abstract and col. 3 lines 18-27; and col. 8 lines 55-60), the map including coded data indicative of an identity of the map and a plurality points **Px** and **Py** of the map (whose geographical location represented by a unique combination of x and y coordinates, are coded and stored at specific addresses in the microprocessor (see col. 9 line 20-23 and col. 10 lines 56-65).
- a processor **30** adapted to:
- identify at least some of the coded data (see abstract ; col. 3 lines 18-27 and col. 8 lines 55-60);
- determine an orientation, of at least some of the coded data (see col. 12 lines 20-30; col. 9 lines 20-23 and col. 10 lines 56-65);
- decode at least some of the coded data (see abstract and col. 9 lines 20-34); and

[1] The Intelligent Paper is dated March/April 1998.

- generate, using at least some of the decoded coded data, indicating data indicative of the identity of the map and a position of the sensing device relative to the map (see col. 12 lines 20-22 and Fig 4 items 114A, 114B); and
- a computer system configured to receive the indicating data from the sensing device **(stylus 20)** (see abstract and col. 8 lines 55-58) and to identify, from the indicative data, the at least one geographic location (see abstract; col. 3 lines 18-27 and col. 8 lines 55-60).

Although Conroy et al. discloses a map included coded data, and a printer, Conroy et al. fails to specifically disclose printing a map, including coded data onto the surface, the map of the geographic area and the coded data being printed substantially simultaneously. Although Conroy et al. discloses a stylus, Conroy et al. fails to disclose that the stylus has a camera for capturing images of at least some of the coded data and said stylus has a processor.

Dymetman et al. (Intelligent paper), on the other hand, discloses printing a map of a geographic location with coded data (see page 396 section 3, Technology wherein a map of Europe is printed on Intelligent paper having two layers of ink and printed on the paper support. The first layer, is the coded layer printed in invisible ink and the second layer is printed in conventional colored inks and is visible to the user). Dymetman et al. further discloses an image sensor for capturing images of at least some of the coded data when the sensing device is placed in an operative position relative to the surface (see page 393 last paragraph; page 397 second paragraph; and page 398 last paragraph).

Dymetman et al. fails to disclose that said pointer or sensing device has a processor.

Dymetman (WO 99/50787) discloses a sensing device having a camera and a processor (see Fig. 8 and page 3 lines 5-8; page 12 lines 3-28 and page 13 lines 14-24).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data, the pointer's camera, and the processor of Dymetman (WO 99/50787) with Conroy et al.'s position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

In regard to claim 11, Conroy et al. discloses a system for enabling a user to designate, in a computer system, at least one geographic location, the system including:

- a globe having a surface on which is disposed a global map (see col. 18 lines 18-20, lines 31-34 and Figs. 11 and 12), the global map including the at least one geographic location and coded data indicative of a plurality of reference points of the globe (see col. 18 lines 18-43);
- a processor **30** adapted to:
- identify at least some of the coded data (see abstract ; col. 3 lines 18-27 and col. 8 lines 55-60);
- determine an orientation, of at least some of the coded data (see col. 12 lines 20-30; col. 9 lines 20-23 and col. 10 lines 56-65);
- decode at least some of the coded data (see abstract and col. 9 lines 20-34); and
- generate, using at least some of the decoded coded data, indicating data indicative of the identity of the map and a position of the sensing device relative to the globe (see col. 12 lines 20-22 and Fig 4 items 114A, 114B); and

- a computer system **(142)** configured to receive the indicating data from the sensing device **(116)** and to identify, from the indicative data, the at least one geographic location (see col. 18 lines 31-52).

Although Conroy et al. discloses a stylus, Conroy et al. fails to disclose that the stylus has a camera for capturing images of at least some of the coded data.

Dymetman et al., on the other hand, discloses an image sensor for capturing images of at least some of the coded data when the sensing device is placed in an operative position relative to the surface (see page 393 last paragraph; page 397 second paragraph; and page 398 last paragraph).

Dymetman et al. fails to disclose that said sensing device has a processor.

Dymetman (WO 99/50787) discloses a sensing device having a camera and a processor (see Fig. 8 and page 3 lines 5-8; page 12 lines 3-28 and page 13 lines 14-24).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s pointer's camera, and the processor of Dymetman (WO 99/50787) with Conroy et al.'s position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

In regard to claim 8, Conroy et al. discloses the map contains geographic features of the geographic area (see col. 18 lines 44-52).

In regard to claim 9, Conroy et al. discloses a map control page including at least one printed map control (see col. 5 lines 12-22 and col. 19 lines 55-57); wherein the computer system is configured to an action associated with the map control when

the map control is designated by the user using the sensing device (see abstract lines 22-28 and col. 8 lines 55-60).

In regard to claim 10, Conroy et al. meets the limitations of claim 9, but fails to disclose that the action is one of printing a map of a designated geographic region.

Dymetman et al. discloses that the action is one of printing a map of a designated geographic region (see Europe map on page 396 Technology).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating method/system because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen map.

Response to Arguments

7. Applicant's arguments filed 3/24/03 have been fully considered but they are not persuasive.

On page 6, Remark, Applicant acknowledges that the Examiner has not taken into consideration the Stephen B. Wicker document.

The reason that such document has not been considered is because a copy of such document is not submitted.

Concerning Item 2 of the remark on pages 6-9, the following features are still considered new matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention:

(a) *" the map of the geographic area and the coded data being printed substantially simultaneously";'*

(b) *"generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity of the position:;*

(c) *"the printer being adapted to print the map and the coded data substantially simultaneously";*

(d) *" comprising a non-electronic printed surface displaying coded data indicative of a plurality of reference points of the globe".*

Applicant's arguments are not convincing because these features can not be found anywhere in the specification.

Applicant's arguments filed on 7/26/02 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marthe Y Marc-Coleman whose telephone number is (703) 305-4970. The examiner can normally be reached on Monday-Thursday from 9:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Patent Examiner
Marthe Y. Marc-Coleman
Marthe Marc-Coleman

June 9, 2003